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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/785,596

02/16/2001

Robert Casper

6208-003

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27383

7590

11/28/2006

CLIFFORD CHANCE US LLP  
31 WEST 52ND STREET  
NEW YORK, NY 10019-6131

EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3691

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/785,596

Applicant(s)

CASPER ET AL.

Examiner

Dan Kesack

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Amendment filed September 14, 2006 has been entered and fully considered. Claims 1-16, and 21 are currently pending. The rejections are as stated below.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "a computer readable medium encoded with a data structure for managing transactional information." The claimed computer readable medium is comprised of a party file, an account file, and a transaction file. While the preamble of claim 1 recites, "for managing transaction information," claims 1-10 do not perform any managing, and therefore it is unclear how managing is performed by the claimed invention.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-10 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The party file, account file, and transaction file recited in claims 1-10 are not statutory because they are not capable of causing functional change in the computer. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized (MPEP § 2106). While Claim 1 recites, "for managing transaction information," this is regarded as intended use because the managing functionality is not present in the body of the claims.

***Claim Rejections - 35 USC § 102***

6. Claims 1, 11, 21 remain rejected under 35 U.S.C. 102(a) as being anticipated by Cochrane et al., U.S. Patent No. 6,460,027, as cited in the previous Office Action.

***Claim Rejections - 35 USC § 103***

7. Claims 2-6 and 12-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Cochrane, as cited in the previous Office Action
8. Claims 7-10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Cochrane as applied to claim 1 above, and further in view of Bromley et al. U.S. Patent No. 5,819,263, as cited in the previous Office Action.

***Response to Arguments***

9. Applicant's arguments filed 9/14/2006 have been fully considered but they are not persuasive.

Regarding the rejection of claims 1-10 under 35 U.S.C. 112, second paragraph, Applicant has amended claim 1 to recite "a computer-readable medium encoded with a data structure", and claims 2-10 to recite "computer readable medium". Examiner respectfully asserts that the amendment does not overcome the previous rejection. Specifically, as cited above, it is still unclear how the computer-readable medium manages the transaction information, as there is no managing functionality in the body of the claims.

Regarding the rejection of claims 1-10 under 35 U.S.C. 101, a computer-readable medium encoded with a data structure comprising files would not, on their own, cause functional change in a computer, and therefore the amended claims lack functional utility. As cited above, files encoded on a computer-readable medium would not cause functional change in a computer.

With respect to Applicant's arguments against the rejection of claims 1, 11, and 21 under 35 U.S.C. 102, Examiner respectfully disagrees. Examiner notes that claim language is given its broadest reasonable interpretation in light of the specification, without reading limitations from the specification into the claims. As cited in the previous Office Action, Cochrane teaches a customer table (party record) containing customer information (party information), wherein the customer is one of a plurality of customers in the database (one of a plurality of parties).

With respect to Applicant's arguments against the rejection of claims 2-6 and 12-16 under 35 U.S.C. 103, Examiner respectfully disagrees. Claim language reciting intended use is not generally given weight for patentability in distinguishing an invention over the prior art. If the prior art is capable of performing the intended use, then it is held that the invention is not patentable over the prior art. In the present invention, claims 2-6 and 12-16 recite names of different parties which may have relating information in the party record. However, in the database schema of the claimed

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invention, the "plurality of parties" are all functionally equivalent, and their only distinguishing characteristic is the individual each "party" represents. Examiner asserts that the customer of Cochrane could be a principal party, an order placer party, a salesperson party, etc., if the invention of Cochrane was used in an environment where such "parties" existed. Since the Examiner interprets the customer and the claimed "parties" to be functionally equivalent, Examiner is of the opinion that Cochrane reads on the claimed invention.

With respect to Applicant's arguments against the rejection of claims 7-10 under 35 U.S.C. 103, Examiner respectfully disagrees. Applicant argues that the mother/daughter relationship of Bromley cited in the previous Office Action is not equivalent to a hierarchical relationship (Remarks filed 9/14/06, page 13). Hierarchy is defined as a ranked order. Therefore, Examiner respectfully asserts that a mother/daughter relationship is a hierarchical because Bromley describes the mother as being above the daughter in authority and access, in relation to the account. Again, Examiner respectfully points out that the cited examples from Applicant's specification are not in the claim language, and therefore the interpretation of "hierarchical relationship" is not exclusively limited to those relationships cited in Applicant's specification.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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HANI M. KAZIMI  
PRIMARY EXAMINER